REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-19 are pending and Claims 20- 25 are cancelled.

35 U.S.C. §102

Claims 20-25 are cancelled, thereby obviating this rejection.

35 U.S.C. §103

Claim 1-9, 10-15, and 16-19 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. Published Patent Application No. 2002/0075145 to Hardman et al. (hereinafter "Hardman") in view of U.S. Patent No. 6,386,772 to Klinefelter et al. (hereinafter "Klinefelter"). The Applicant respectfully traverses the rejection.

First, it is respectfully submitted that Hardman is nonanalogous art in relation to the recited features of Claims 1-9, 10-15, and 16-19. As the Examiner is well aware, "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See MPEP 2141.01.

The Applicant respectfully asserts that Hardman in nonanalogous art and may not be relied upon in the rejection of the above referenced claims. Hardman is drawn exclusively towards a tire monitoring system. For example, Hardman recites that the "present invention relates in general to tire parameter monitoring systems and in particular to an electronic tire management system including tire tags," *See Hardman, Page 1, Paragraph [002].* Hardman therefore limits its own scope to tire monitoring. Hardman repeatedly refers to

"tire tags", "tire data", and defines the system as "Electronic Tire tag Management System (ETMS)" and does not disclose any other contemplated use. *See Hardman.* Hardman merely describes a system for retrieving tire parameter data from tires. Hardman is not drawn to and does not suggest any application outside of monitoring tires.

The subject Application, however, relates generally to managing data collected from printing devices and more particularly to retrieving data from printing device components that have memory and utilizing the printing device data to provide improved customer service. Nowhere in Hardman is there disclosure, teaching or suggestion of printing devices, printers, printer data, or the like. Hardman does not describe any other use besides tire monitoring. Therefore, an artisan in the Applicant's field of endeavor seeking to manage data collected from printing device simply would not turn to a tire monitoring system as described in Hardman. Accordingly, Hardman is non-analogous prior art.

In addition to reliance on nonanalogous art, it is respectfully submitted that the combination of references suggested by the Office herein rejecting the above referenced claims is defective. When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141* and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986). The features of Claims 1-9, 10-15, and 16-19 are not disclosed, taught or suggested by the cited

art, alone or in combination. Additionally, the Examiner has engaged in impermissible hindsight reconstruction. Further discussion of these arguments may found in relation to the following claims.

Claim 1 recites a method that includes "retrieving printing device data from component memory of a replaceable component from a printing device used by a customer; storing the printing device data in a customer database". As previously described, Hardman does not teach or suggest "printing device data", "component memory" integrated with a "replaceable printer component", or "printing device data is retrieved from the component memory and stored in the customer database" as recited in Claim 1.

The Examiner asserts that "[a]s for the limitation of 'printing device' data, this is non-functional language and carry no-patentable weight since it's merely non-functional data on a storage device". *See Office Action Dated June 16, 2005, Page 6.* This is not the case, Claim 1 recites "retrieving printing device data from component memory of a replaceable component from a printing device used by a customer" which positively recites a device involved in the performance of the "retrieving". Therefore, this is functional language and the Examiner is not free to ignore this feature of the recited claim.

Regardless, the Examiner then asserts Klinefelter to correct the defects of Hardman, and more particularly the absence in Hardman of any mention whatsoever of a device other than a tire. Namely, the Examiner asserts that Klinefelter "teaches the retrieving of data from component memory (tag/memory tag) of a replaceable component (toner/ink cartridge) from a device (i.e. printing device) used by a customer {see Figs. 9, 7 or col. 5, line 5 to col. 6, line 61, col. 1, lines 5-18}". The Applicant respectfully disagrees.

Klinefelter describes communication of information within an electronic printer. For example, a make and supplier of a ribbon may be included such

that operation of a print head may be optimized by communicating this information from the ribbon to the electronic printer. *See Klinefelter, Col. 5, Lines 60-67.* Thus, the information communicated within Klinefelter serves the sole purpose of informing the printer of materials being used and does not teach or suggest the recited method. Klinefelter does not teach or suggest any other use of the data.

The Applicant respectfully submits that the Office has not provided the required teaching or suggestion from the prior art to make the claimed combination, and rather has engaged in impermissible hindsight reconstruction. As previously described, Hardman is drawn exclusively towards a tire monitoring system. Hardman recites that the "present invention relates in general to tire parameter monitoring systems and in particular to an electronic tire management system including tire tags," *See Hardman, Page 1, Paragraph [002].* Hardman therefore limits its own scope to tire monitoring. Hardman repeatedly refers to "tire tags", "tire data", and defines the system as "Electronic Tire tag Management System (ETMS)" and does not disclose any other contemplated use. *See Hardman.* However, each of the recited features of Claim 1, e.g., the "retrieving", the "storing", the "associating" and the "accessing", involve printing device data.

Klinefelter describes communication of data within a printer and does not describe any other contemplated use other than use within the printer itself to perform printing functions, such as to control a print head. Therefore, a skilled artisan, when viewing both references, would not be motivated to make the proposed combination absent the present disclosure.

The Examiner asserts in the Office Action that "Clearly, the mere applying the same essential retrieving, storing, associating and accessing the data steps from a memory tag of a replaceable component to/of any other

device would have been obvious to a skilled artisan since the type or different function of the device is not critical and any device can be used". *See Office Action Dated June 16, 2005, Pages 6-7.* The Applicant strongly disagrees and respectfully requests the Examiner to cite any statutory authority that supports this assertion. Claim 1, as originally filed, particular recites printer data and therefore is drawn with particularity to printer data. Hardman, however, merely recites tire tag data and does not describe any use whatsoever outside of tires. Therefore, Hardman itself supports the Applicant's contention that the present claim is nonobvious, since the lack of support within Hardman for any other contemplated use whatsoever, much less printer use, shows the narrow scope of the problem being addressed by Hardman. The Examiner is now not free, with the benefit of hindsight reconstruction afforded by the present Application, to then expand the scope of Hardman beyond its expressed teachings. Klinefelter does not correct this defect, as it is relied on solely for mention of a printer. Accordingly, Claim 1 is allowable and withdrawal of the rejection is respectfully requested.

Additionally, in regards to dependent Claims 2-9, the Applicant strongly disagrees with the assertion again made by the Examiner that the recited features of Applicant's invention are "non-essential to the claimed invention". *Office Action Dated June 16, 2005, Pages 7-9.* The Applicant's invention in the case of each claim includes everything which is recited in the claim. Contrary to the Examiner's assertion, the recited features further define the claimed invention and are essential. Recited features may not simply be dismissed as non-essential to the claimed invention. Rather, "The prior art reference (or references when combined) must teach or suggest all the claim limitations". *See MPEP 2143.* In addition, the Applicant strongly disagrees with the "fairly taught" standard repeatedly asserted by the Examiner. *See e.g.,*

Office Action Dated June 16, 2005, Page 7-9. To the extent that "fairly taught" as asserted by the Examiner deviates from the statutory requirements for patentability the standard is erroneous.

Further, as the Examiner is aware, the Examiner "ordinarily should reject each claim on all valid grounds available." *M.P.E.P. §707.07(g)* Further, "[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression." *Id.* The Examiner's action should be complete as to all matters. *37 C.F.R. 1.104* and *M.P.E.P. §707.07(a)*. Failure to provide a full development of the reasons removes any opportunity for the Applicant to rebut any reasoning used by the Examiner in making the rejections. Therefore, full development of the reasons or withdrawal of the rejection is requested.

Claim 2 recites "the printing device data further comprises information that uniquely identifies the printing device". **Claim 3** recites "the printing device data further comprises information regarding usage of the printing device". Hardman does not teach or suggest information that uniquely identifies the printing device as recited in Claim 2. Additionally, Hardman does not teach or suggest information regarding usage of the printing device as recited in claim 3. Hardman does not discuss information about the printer or usage. Rather, the portions of Hardman relied upon by the Examiner merely describe the outputting of tire parameter data locally or remotely, tire and tire tag serial numbers, tire tag features, and the editing of vehicle and tire data on a tire tag. *See Hardman Paragraphs [0119],[0145],[0149],[0265] and [0309].* Hardman is narrowly drawn to tire parameter monitoring. Indeed, Hardman includes a very extensive "Field of the Invention" section that is limited exclusively to tire monitoring. Hardman does not discuss printer device data, or printer information at all. Klinefelter does not correct these defects, alone or

in combination with Hardman. Since Klinefelter identifies components (e.g., a ribbon) and not a printing device, Klinefelter cannot correct the defects of Hardman. Thus, these claims are allowable as written.

Claim 4 recites "wherein the accessing the printing device data in the customer database further comprises accessing previously stored database information related to the customer". **Claim 5** recites "wherein the previously stored database information is derived from memory of previously returned components". The Examiner relies upon portions of Hardman that describe only "tire history data" downloaded or transferred **from a tire tag**. *See Hardman, Paragraphs [0151], [0152], and [0169].* Hardman fails to disclose "accessing the printing device data in the customer database" or "accessing previously stored database information related to the customer" as recited in claim 4. Additionally, Hardman fails to disclose accessing previously stored database information "from the memory of previously returned components" as recited in claim 5. Further, Hardman fails to teach or suggest "previously returned components" at all. Klinefelter does not correct these defects, alone or in combination with Hardman. Thus, Hardman and Klinefelter fail to teach or suggest all the claim features of claims 4-5.

Claim 6 recites "wherein the previously stored database information is derived from information submitted by the customer on a registration card". Examiner relies upon portions of Hardman that fail to disclose "information submitted upon a registration card" as recited in Claim 6. *See Hardman Paragraph, [0145] and [0152].* Hardman does not mention a registration card, and thus fails to teach or suggest all the claimed features of claim 6. Klinefelter does not correct these defects, alone or in combination with Hardman. Thus, Hardman and Klinefelter fail to teach or suggest all the claim features of claim 6.

Claim 7 recites "wherein the printing device is a laser printer and the replaceable component is a toner cartridge". The Examiner yet again asserts that this feature is non-essential to the claimed invention, which again is improper.

Claim 8 recites "further comprising associating rules to be followed when printing device data associated with a customer meets certain criteria". Examiner relies upon a portion of Hardman which describes calculating Cold Fill Inflation Pressure and comparing to a specified target. *See Hardman Paragraph [0224].* Hardman, however, fails to disclose "associating rules to be followed when printing device data associated with a customer meets certain criteria" as recited in Claim 8. Klinefelter does not correct this defect, alone or in combination with Hardman. Thus, Hardman and Klinefelter fail to teach or suggest all the claimed features of Claim 8.

Claim 9 recites a method comprising in part "testing the replaceable component for a defect", "storing defect information in the customer database", "associating the defect information to one or more other customers referred to in the customer database that use a similar replaceable component" and "wherein the accessing the printing device data further comprises accessing the defect information in the customer database". The Examiner relies upon a portion of Hardman which describes using actual tire parameter data from a tire tag to determine which tires "are in need of service, such as being under-inflated" such that they "can be attended to immediately" while "other tires that require no service can then be given no attention other than a routine visual inspection". *See Hardman Paragraphs [0234]-[0235].* Hardman describes using tire tag data to determine which tires should be serviced. Hardman does not teach or suggest the above recited features of Claim 9. Hardman fails to teach or suggest "testing for the replaceable component for a defect", "storing

defect information", "associating defect information to one or more other customers", or "accessing the defect information" as recited in claim 9. Indeed, Hardman does not describe defect testing or storing/accessing defect information at all. Klinefelter does not correct this defect, alone or in combination with Hardman, and thus these references fail to teach or suggest all the claimed features of Claim 9.

Additionally, Claims 2-9 depend directly or indirectly from Claim 1 and are allowable for at least the same reasons as stated with respect to Claim 1. These claims are also allowable for their own recited features as discussed previously, which are not disclosed, taught or suggested by the submitted references, alone or in combination. Accordingly, for these and other reasons, the Applicant respectfully requests that the §103 rejection of Claims 2-9 be withdrawn.

Claim 10 recites a system that includes "printing device replaceable component including component memory integrated therewith", "a customer database that stores customer information for multiple customers, including printing devices and printing device replaceable components used by the customers" and "printing device data is retrieved from the component memory and stored in the customer database". **Claim 16** recites a method that includes "printing devices that use replaceable components with integrated component memory" and "compiling data retrieved from the component memory of a plurality of replaceable components into a customer database". Neither Hardman nor Klinefelter, alone or in combination, disclose, teach or suggest these aspects.

As previously described with respect to Claim 1, Hardman does not disclose, teach or suggest a "printing device" or "component memory" as recited in Claims 10 and 16. The combination of Hardman with Klinefelter

does not teach or suggest the claimed features. Further, for reasons previously recited with respect to Claim 1, the Office's rejection of Claim 10 depends upon hindsight knowledge of the Applicant's invention which is impermissible. Accordingly, the Applicant respectfully requests that the §103 rejection of Claims 10 and 16 be withdrawn.

Claims 11-15 depend directly or indirectly from Claim 10 and are allowable for at least the same reasons as stated with respect to Claim 10. These claims are also allowable for their own recited features, which are not disclosed, taught or suggest by the submitted references, alone or in combination. The discussion above with respect to claims 2-9 is pertinent to claims 11-15 as well. Therefore, the Applicant will not further burden the record by repeating the above remarks. Accordingly, Hardman fails to teach or suggest the recited features of claims 11-15 for the corresponding reasons set forth above with respect to claims 2-9. For at least these reasons, Applicant respectfully requests that the §103 rejection of claims 11-15 be withdrawn.

Claims 17-19 depend directly or indirectly from Claim 16 and are allowable for at least the same reasons as stated with respect to Claim 16. These claims are also allowable for their own recited features, which are not disclosed, taught or suggest by the submitted references, alone or in combination.

Specifically, Claim 17 recites "storing customer information for a customer in the customer database and associating the customer information with compiled data that is related to a printing device used by the customer". Hardman and Klinefelter fail to teach or suggest "associating the customer information with compiled data that is related to a printing device used by the customer" as recited in Claim 17. Claim 18 recites "acquiring the customer information for the customer from a registration card used to register the

customer as the purchaser of the printing device used by the customer". Claim 18 is rejected for the same reason as set forth for Claim 6. As with Claim 6 discussed above, Hardman and Klinefelter, alone or in combination, fail to teach or suggest "a registration card" as recited in claim 18. Claim 19 recites "associating the customer information with general data related to a printing device or printing device replaceable component used by a customer". As discussed previously, Hardman deals with tires and not printer devices, and Klinefelter is not properly combinable with Hardman. Hardman does not teach or suggest "printing device" or "printing device replaceable component" as recited in claim 19. For at least the above reasons, Applicant respectfully requests that the §103 rejection of claims 17-19 be withdrawn.

Finally, the Applicant again strongly disagrees with the Examiner's assertion that Hardman's self-serving boilerplate about the scope of the claims and equivalents thereof renders Applicant's invention obvious. For example, the Examiner asserts the following:

> Note on [309] and [313], Hardman et al discloses that any other desired device or parameters can be implemented and that other element, steps, methods and techniques that are insubstantially different form those described herein are also within the scope of the invention. Thus the scope of the invention should not be limited by the particular embodiments described herein but should be defined by the appended claims and equivalents thereof. Changing to other type of device or component would be considered as selecting other equivalent device and component and would have been obvious, absent evidence of unexpected results. *Office Action Dated June 16, 2005, Pages 11-12.*

Applicant respectfully disagrees that the scope of the invention in Hardman is expanded by the described boilerplate language. This type of language does not expand the scope of Hardman beyond the described limited scope of tire tags. As previously stated, when applying 35 U.S.C. § 103, "the references must be

considered as a whole and must suggest the desirability and thus the obviousness of making the combination" and "must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention". *See MPEP § 2141* and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986). Nowhere in the asserted boilerplate is the desirability of the modification suggested without engaging in impermissible hindsight vision afforded by the claims of the subject Application.

Further, [313] states "it will be obvious to those skilled in the art that changes and modifications of the present invention, in its various embodiments, may be made **without departing from the spirit and scope of the invention.**" The spirit and scope of Hardman is clearly limited to tire tags and tire parameter monitoring. This language is clearly limiting and should not serve to broaden the scope of Hardman, and most certainly cannot be used as a basis for rendering the Applicant's invention obvious.

Conclusion

For at least the above reasons, all pending claims 1-19 are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the subject application. If any issues remain that prevent issuance of this application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully submitted,

Dated: 8/31/5 By: _____

William J. Breen III
Reg. No. 45,313
(509) 324-9256 ext. 249